

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated August 16, 2005, indicated that the election with traverse of Group I filed on June 3, 2005, is acknowledged; claims 1, 4, 16-28, 30-33 are rejected under 35 U.S.C. § 102(e) over Kubler *et al.* (U.S. Patent No. 5,726,984); claims 2, 3, 5, 6, 12 and 29 are rejected under 35 U.S.C. § 103(a) over Kubler *et al.* in view of Kuthyar *et al.* (U.S. Patent No. 5,909,431), Shinohara *et al.* (U.S. Patent No. 5,351,237); claims 7 and 10 are rejected under 35 U.S.C. § 103(a) over Kubler *et al.* in view of Schulzrinne *et al.* (RFC 1889); and claims 8, 9 and 11 are rejected under 35 U.S.C. § 103(a) over Kubler *et al.* in view of Kuthyar *et al.* and Shinohara *et al.* as applied to claims 1, 4, 5 above, and further in view of Schulzrinne *et al.*

Applicant appreciates the Examiner's telephone call of October 12, 2005 to Attorney Eric J. Curtin, during which we discussed the very lengthy '984 reference and its approach to call routing. As discussed over the telephone, Applicant's review of the '984 reference indicates that the reference does not teach or suggest limitations directed to determining (*i.e.*, selecting) an Internet protocol or standard switched telephone network to use in response to the Internet connectivity status of a telephone addressee. At the Examiner's suggestion, Applicant has provided detailed explanation as to this position (and others as appropriate) in the text of the Remarks below. Applicant invites the Examiner to telephone the undersigned to facilitate the prosecution of this matter.

To facilitate prosecution, Applicant has cancelled claims 34-38 as required by the Examiner; Applicant maintains the traversal of the related restriction to these claims.

Applicant traverses all of the claim rejections under §§102(e) and 103(a), each of which improperly relies upon the primary '984 (Kubler) reference, because the '984 reference does not correspond to (or, in the context of the §103(a) rejections, teach or suggest) the claimed limitations as indicated in the Final Office Action. Various portions of the '984 reference fail to correspond to the claimed invention as discussed, for example, in the Office Action Response filed on June 24, 2005 (incorporated herein). For brevity, Applicant has directed the following discussion to claimed limitations relating to the

determination of a telephone connectivity approach (*e.g.*, Internet protocol telephony or standard switched telephony) as a function of the Internet protocol connectivity status of the telephonic communication addressee. The analysis below clearly shows the lack of correspondence between the '984 reference and the claimed limitations, such that review of the following demonstrates the impropriety of all of the claim rejections (thus, without necessarily requiring the Examiner or the Appeal Board, if appropriate, to consider other improprieties of the claim rejections).

The claim rejections in the Final Office Action suggest that the '984 reference's processing circuit 5609 operates to determine a telephony connection approach as a function of an Internet connectivity status of a telephonic communication addressee (*e.g.*, a dialed Internet telephone). However, the portions of the '984 reference cited in the Final Office Action, clearly show that the '984 reference is limited in application to responding to commands or predefined lists when selecting a telephony communication approach. That is, the '984 reference relies upon user input as to the type of telephone communication link to use when calling a telephone addressee. The '984 reference does not teach or suggest any implementation in which the processing circuit 5609 actually determines an approach to establishing telephonic communications as a function of Internet connectivity status of a telephone addressee. As discussed further below, the only action apparently taken in response to Internet connectivity status (*e.g.*, as indicated in column 100 of the '984 reference), is to inform a user that a telephone addressee is offline; there is no determination made by the processing circuit 5609 directly in response to this offline condition.

Referring to FIG. 55a, FIG. 56a and corresponding discussion at columns 87 and 88 of the '984 reference, the processing circuit 5609 provides telephone signals (*e.g.*, dial tone) to a local telephone (*e.g.*, 5530), receives input from the local telephone and routes telephone calls using information in a stored database. In some applications, the processing circuit 5609 uses a particular call routing approach in response to inputs from a user at the local telephone who selects type of telephone communication link to use, in addition to providing a telephone number to call (*see, e.g.*, column 88, lines 6-17 and 48-64). The processing circuit 5609 accordingly operates with a host (*e.g.*, computer 5515) to respond to a telephone number provided by a local telephone to either select a

predefined routing approach or respond to a user-selected routing approach provided via the local telephone. The processing circuit 5609 does not, however, determine a routing approach in the context of the presently-claimed invention, as a function of Internet connectivity status (*e.g.*, as claim 1 is directed) or any other condition.

The Examiner's approach to modifying the processing circuit 5609 in accordance with FIG. 63 and corresponding discussion at columns 100 and 101 of the '984 reference also fails because these newly-cited portions do not describe, teach or suggest determining a telephone call routing approach in response to Internet connectivity of a telephone addressee. Instead, these newly-cited portions of the '984 reference are apparently limited to the simple communication of an offline telephone condition to a user attempting to make a telephone call. The '984 reference does not make any call routing determination in connection with that offline condition; on the contrary, the call routing determination (*e.g.*, Internet versus standard switched routing) is made by the user. For example, referring to lines 27-34 of column 100 of the '984 reference, the computer 6301 receives a "no response and timeout" if a telephone call recipient at computer 6303 is offline. In response, the computer 6301 "sends a voice message to the telephone 6321 indicating that the telephone 6323 is offline." The computer 6301 does not determine "whether the audio information received from the telephone is to be coupled to ... establish a standard telephonic communication ... [or] processed in accordance with the standard Internet transfer protocols" as a function of Internet protocol connectivity status of a telephonic communication addressee (*e.g.*, as claim 1 is directed).

In contrast to the suggestion in the Final Office Action, any "determination" of a telephone connection approach, it appears, is made only by a user interacting with the computer 6301 to provide an input selection, directly or via stored preferences; this approach teaches away from the claimed limitations. As discussed in the Office Action Response filed on June 9, 2005, the purpose of the '984 reference is directed to a user-designation of an approach for routing calls via stored information or user input, such that the processing circuit 5609 cannot automatically determine call routing characteristics based on designated telephonic communication addressee connectivity. *See, e.g.*, column 88, lines 6-17. Thus, the processing circuit 5609 (and the computer card 5601) cannot, as

the Examiner asserts, determine whether audio information is to be coupled to a standard telephone network or an Internet communication network as a function of Internet connectivity of the telephone addressee. Any such operation would be contrary to the purpose of (and therefore undermine) the '984 reference.

In view of the above, no portion of the '984 reference appears to correspond directly to (or to even teach or suggest) the above-referenced claim limitations directed to automatic call connection/routing determination as a function of Internet connectivity.

Applicant further submits that the cited portions of the '984 reference at columns 100 and 101 make no reference to any operation of the processing circuit 5609, as alleged on pages 3-4 of the Final Office Action. In this regard, the proposed modification of the processing circuit 5609 relies upon unrelated portions of the same reference. The M.P.E.P. and relevant case law indicates that such modification is improper in that there must be motivation to modify the processing circuit 5609 as suggested, yet no such motivation or explanation has been provided.

Moreover, as such a modification appears necessary in order to maintain the rejection, Applicant submits that the claim rejections under Section 102(e) fail because such a modification is contrary to the requirements for establishing a Section 102 rejection (*i.e.*, modification necessitates a Section 103-type rejection). Specifically, the rejection attempts to modify the processing unit 5609, shown in FIG. 56a and discussed at column 87, with the Internet service arrangement shown in FIG. 63 and discussed at column 100, without providing any explanation as to how such a modification would operate and without providing any evidence of motivation to make such a modification.

Considering the above, Applicant submits that the Section 103(a) rejections fail because the asserted teachings of the '984 reference do not correspond to the claimed limitations. In addition, various other improprieties remain with the Section 103 rejections, as stated in previous Office Action Responses of record, which are fully incorporated herein by reference. However, as stated above, the failure of the '984 reference to teach or suggest call-connection limitations as indicated renders all of the claim rejections improper. Therefore, the Section 103(a) rejections are also improper and should be removed.

Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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Dated: October 14, 2005

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